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10/605,437	09/30/2003	Edward E. Kelley	FIS920030205US1	2436

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EXAMINER
CHANG, JUNGWON

ART UNIT	PAPER NUMBER
2154	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2003*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-45* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18,22-39 and 42-45* is/are rejected.

7)☒ Claim(s) *19-21,40 and 41* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *9/30/03,10/31/03*.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-45 are presented for examination.

2.   The Information Disclosure Statements filed on 9/30/03 and 10/31/03 have been

considered.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-15, 22-36 and 42-45 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Packer (US 7,421,498), in view of Kohn (US 2003/0229672), Takatori

et al, (US 2006/0059231), hereinafter Takatori.

5.   As to claims 1 and 42, Packer discloses the invention as claimed, including a

method for providing autonomic identification of an important message addressed to a

recipient email subscriber (fig. 6), comprising:

        scanning an email message received over a network, said scanning operable for

identifying a Uniform Resource Locator contained in said email message (604-606, fig.

6; col. 2, lines 19-21); and

if a Uniform Resource Locator is found: comparing said Uniform Resource

Locator with contents of a history file, said history file storing a listing of Uniform

Resource Locators (610, fig. 6; col. 5, lines 4-25, "URL database 116 which includes a

list of URLs"; col. 5, lines 28-67 "the URL parser 110 presents each URL found in the

electronic communication to the tool kit");

performing analytics for said Uniform Resource Locator based upon said

contents of said history file, said performing analytics resulting in a rating assigned to

said Uniform Resource Locator (612-614, fig. 6; col. 5, lines 16-67, "looks up the

category or rating in the database 116"); and

if said rating meets a minimum standard set for qualifying said Uniform Resource

Locator as relevant (408, fig. 4; 614, fig. 6; col. 5, line 16 – col. 6, line 12); and

forwarding said email message to said recipient email subscriber (608, fig. 6).

6.   Packer does not specifically disclose flagging said email message. Kohn

discloses flagging said email message (20, fig. 2; page 2, 0012, "tagging the email

message"; page 2, 0022-0023; page 4, 0043). It would have been obvious to one of

ordinary skill in the art at the time of the invention was made to combine the teaching of

Packer and Kohn because Kohn's teaching would efficiently determine the email

message by displaying the tagged email to the user computer, as taught by Kohn, page

2, 0012.

Parker does not specifically disclose URLs are previously accessed by said recipient

email subscriber. Takatori discloses URLs are previously accessed by said recipient

email subscriber (fig. 6; page 1, 0008, "URL memory for storing a URL bookmarked by

the user"; page 3, 0026-0028; page 8, 0109-0112). It would have been obvious to one

of ordinary skill in the art at the time of the invention was made to combine the teaching

of Packer and Takatori because Takatori's teaching would prevent from being received

by determining the URL information attached in the email, as taught by Takatori, page

3, 0028.

7.   As to claim 22, it is rejected for the same reasons set forth in claim 1 above. In

addition, Packer discloses a storage medium encoded with machine-readable computer

program code for providing autonomic identification of an important message addressed

to a recipient email subscriber, said storage medium including instructions for causing a

computer to implement a method (col. 3, line 63 – col. 4, line 10).

8.   As to claims 2 and 23, Packer discloses, further comprising: forwarding said

email message without a flag to said recipient email subscriber if at least one of: a

Uniform Resource Locator has not been found; and a rating fails to meet said minimum

standard set for qualifying said Uniform Resource Locator as relevant (606-616, fig. 6).

9.   As to claims 3 and 24, Packer discloses, further comprising: updating contents of

said history file to include said Uniform Resource Locator found as a result of said

scanning (col. 5, lines 4-25, "URL database 116 which includes a list of URLs"; col. 5,

lines 28-67; "database inherently updates contents stored therein").

10.   As to claims 4, 25, 43 and 44, Packer discloses, wherein said performing

analytics for said Uniform Resource Locator based upon contents of said history file

includes at least one of: evaluating frequency in which said recipient email subscriber

accessed said Uniform Resource Locator; evaluating how recently said recipient email

subscriber accessed said Uniform Resource Locator; and evaluating said Uniform

Resource Locator in context with relevance rules established by said recipient email

subscriber (610, fig. 6; col. 5, lines 4-25, "URL database 116 which includes a list of

URLs"; col. 5, lines 28-67 "the URL parser 110 presents each URL found in the

electronic communication to the tool kit").

11.   As to claims 5 and 26, Packer discloses, wherein said relevance rules include at

least one of: assigning relevance to a specific Uniform Resource Locator; establishing

limits on a number of Uniform Resource Locators qualified to be relevant; applying

weighting factors to specific types of Uniform Resource Locators; and applying

weighting factors to Uniform Resource Locators based upon measurements of usage

and time factors (408, fig. 4; 614, fig. 6; col. 5, line 16 – col. 6, line 12).

12.   As to claims 6, 27 and 45, they are rejected for the same reasons set forth in

claims 1, 22 and 42 above.

13.   As to claims 7 and 28, Packer discloses, further comprising deploying process software for providing said autonomic identification of an important message addressed to a recipient email subscriber, said deploying comprising: installing said process software on at least one server; identifying server addresses for users accessing said process software on said at least one server; installing a proxy server if needed; sending said process software to said at least one server and copying said process software to a file system of said at least one server; sending the process software to at least a first client computer; and executing said process software on said first client computer (col. 3, line 63 – col. 4, line 10).

14.   As to claims 8 and 29, Packer discloses, wherein said installing said process software further comprises: determining if programs will reside on said at least one server when said process software is executed; identifying said at least one server that will execute said process software; and transferring said process software to storage for said at least one server (col. 3, line 63 – col. 4, line 10).

15.   As to claims 9 and 30, Packer discloses, wherein said sending said process software to said first client computer further includes having said at least one server automatically copy said process software to said first client computer, and running an installation program at said first client computer to install said process software on said first client computer (col. 3, line 63 – col. 4, line 10).

16.   As to claims 10 and 31, Packer discloses, wherein said sending said process

software to said first client computer further comprises identifying a user and an address

of said first client computer (604-606, fig. 6; col. 2, lines 19-21, "filtering").

17.   As to claims 11 and 32, Packer discloses, wherein said sending said process

software to said first client computer includes sending said process software to at least

one directory on said first client computer (col. 3, line 63 – col. 4, line 10).

18.   As to claims 12 and 33, Packer discloses, wherein said sending said process

software to said first client computer includes sending said process software to said first

client computer via e-mail (col. 2, lines 19-60).

19.   As to claims 13 and 34, Packer discloses, further comprising integrating process

software for providing said autonomic identification of an important message addressed

to a recipient email subscriber, said integrating comprising: determining if said process

software will execute on at least one server; identifying an address of said at least one

server; checking said at least one server for operating systems, applications, and

version numbers for validation with said process software, and identifying any missing

software applications for said at least one server that are required for integration;

updating said at least one server with respect to any operating system and application

that is not validated for said process software, and providing any of said missing

software applications for said at least one server required for said integration; identifying

client addresses and checking client computers for operating systems, applications, and

version numbers for validation with said process software, and identifying any software

applications missing from said client computers that are required for integration;

updating said client computers with respect to any operating system and application that

is not validated for said process software, and providing any missing software

application for said client computers required for said integration; and installing said

process software on said client computers and said at least one server (604-606, fig. 6;

col. 2, lines 19-60, "scanning email messages")

20.   As to claims 14 and 35, Packer discloses, further comprising on demand sharing

of process software for providing said autonomic identification of an important message

addressed to a recipient email subscriber, said on demand sharing comprising: creating

a transaction containing unique customer identification, requested service type, and

service parameters; sending said transaction to at least one main server; querying said

at least one main server about processing capacity associated with said at least one

main server to help ensure availability of adequate resources for processing of said

transaction; and allocating additional processing capacity when additional capacity

appears needed to process said transaction, said additional processing capacity being

selected from the group of additional capacities consisting of central processing unit

capacity, processor memory capacity, network bandwidth capacity, and storage

capacity (col. 14, lines 12-54, "having capability"; col. 14, lien 61 – col. 15, line 41).

21.   As to claims 15 and 36, Packer discloses, further comprising recording a plurality

of usage measurements selected from the group of usage measurements consisting of

network bandwidth, processor memory, storage, and central processing unit cycles (col.

14, lines 12-54, "having capability"; col. 14, lien 61 – col. 15, line 41).

22.   Claims 19-21 and 40-41 are objected to as being dependent upon a rejected

base claim, but would be allowable if rewritten in independent form including all of the

limitations of the base claim and any intervening claims.

23.   Claims 16-18 and 37-39 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Packer, Kohn, Takatori, further in view of Suzuki et al, (US

2003/0158904), hereinafter Suzuki.

24.   As to claims 16-18 and 37-39, Packer does not specifically disclose summing

said usage measurements; acquiring at least one multiplicative value associated with

said usage measurements and with unit costs; and recording any such acquired

multiplicative value as an on demand charge to a requesting customer. However,

Suzuki discloses summing said usage measurements; acquiring at least one

multiplicative value associated with said usage measurements and with unit costs; and

recording any such acquired multiplicative value as an on demand charge to a

requesting customer (page 9, 0099-0100; page 13, 0123). It would have been obvious

to one of ordinary skill in the art at the time of the invention was made to combine the

teaching of Packer and Suzuki because Suzuki's teaching would determine a

communication fee and usage fee of service email, as taught by Suzuki, page 9, 0099.

Conclusion

25.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

McLellan et al, US 6,854,074, Bandini et al, US 2002/0199095 disclose method and

system for identifying appropriate email having URLs.

26.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JUNGWON CHANG whose telephone number is

(571)272-3960. The examiner can normally be reached on M-F 6:30 - 2:00.

      If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Nathan Flynn can be reached on 571-272-1915. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

      Information regarding the status of an application may be obtained from the

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system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JUNGWON CHANG/
Primary Examiner, Art Unit 2154
September 30, 2008